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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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on September 28, 2005

Signature

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name

Shelley Victoria

Application Number

09/497,383

Filed

2/3/2000

First Named Inventor

David L. Bahr

Art Unit

Examiner

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record. 34,633

Registration number

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature
Jon M. Jurgovan

Typed or printed name

404-881-4583

Telephone number

Date

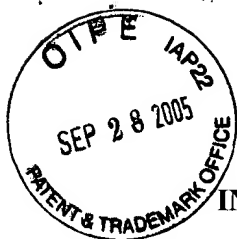
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 09/497,383 Confirmation No.: 7431
Applicant(s): David L. Bahr et al
Filed: Feb. 3, 2000
Art Unit: 2143
Examiner: Neurauter, Jr., George C.
Title: SYSTEM AND METHOD FOR SCANNING A DOCUMENT
IN A CLIENT/SERVER ENVIRONMENT

Docket No.: 047307/258663
Customer No.: 00826

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant hereby submits its Remarks in support of its Pre-Appeal Brief Request for Review.
Applicant requests Pre-Appeal Brief Review for the following reasons.

1. Quillix Data Sheet is Not Prior Art

In the Office Action dated August 15, 2005, Claims 1-16, 18-27, 29-33, 35-53 and 55-75 of the above-identified application were rejected under 35 U.S.C. 103(a). As noted on Page 18 of Applicant's Amendment dated July 21, 2005, the primary reference relied upon to reject the Claims is a Data Sheet regarding a Quillix software product ("Quillix Data Sheet") by Prevalent Software, Inc.

The Quillix Data Sheet bears a print date of March 28, 2000, which is necessarily the earliest possible date on which the Quillix Data Sheet could have been published. The subject application was filed on February 2, 2000. Thus, the Quillix Data Sheet is not a publication that would constitute prior art under 35 U.S.C. 102 or 103(a).

Accordingly, the review board is requested to reverse the rejection and remand with instructions to the Examiner not to rely upon the Quillix Data Sheet as prior art and to issue a Notice of Allowance for all pending Claims.

2. Applicant's Statement Regarding Quillix Press Release and Product is not Admission of Prior Art

In the Office Action dated August 15, 2005, Claims 1-16, 18-27, 29-33, 35-53 and 55-75 of the above-identified application were rejected under 35 U.S.C. 103(a). The Examiner cites the "Quillix Data Sheet" as the primary reference under 35 U.S.C. 103(a), asserting that Applicant's characterization of a Quillix Press Release and Product on the record is an admission that the Quillix Data Sheet is prior art.

The statement allegedly admitting that the Quillix Data Sheet is prior art appears at pages 60-61 of Applicant's Amendment filed May 7, 2004, which is set forth as follows:

Thus, according to Prevalent Software, Inc., "Quillix is the first true enterprise, distributed capture system built for the Internet." Further, IDT's President characterizes the Quillix solution as "a revolutionary document and data capture product for the eCommerce industry." This is further evidence of the long-felt need in the art for the claimed invention – to be the "first true enterprise, distributed capture system built for the Internet," and "revolutionary," there must have been a long-felt need for the claimed invention (not to mention attempts by others that had failed to attain the claimed invention). Because Quillix appears to contain similar or the same functionality as the claimed invention, it is submitted that there was a long-felt need in the art for the claimed invention that was not satisfied until the claimed invention was made. [Emphasis added]

Contrary to the Examiner's assertion, this statement does not admit that the Quillix Data Sheet is "prior art." The point made in this statement is merely that Prevalent Software, Inc's President considered his company's product "revolutionary" and the "first true enterprise, distributed capture system built for the Internet." In fact, Applicant's inventors were the first to invent the claimed subject matter. However, that another company regarded its product as new at a point in time near the filing date of the claimed invention tends to show that the claimed invention was new to the extent the two have the same or similar features. The Examiner has failed to consider that the claimed invention was invented before the Quillix Data Sheet so that it is not prior art to the subject application, and this conclusion is in no way inconsistent with Applicant's statement above.

Also, the statement indicates that the long-felt need for the invention was not satisfied until the claimed invention, not the Quillix product, was made. Logically, this statement could only properly be interpreted to mean that the claimed invention is patentable over the Quillix Data Sheet, Press Release or Product (Exhibit 21 - Amendment filed May 7, 2004).

Moreover, use of the phrase “appears to contain similar or the same functionality” allows that the Quillix software may not be the same as the claimed invention, but only similar, given the documents of record (e.g., Exhibit 21, Amendment filed May 7, 2004) do not disclose the claimed invention.

Subsequent to the May 7, 2004 Response, in Applicant’s Amendment filed February 14, 2005, numerous Claims were amended. For example, Claim 1 was amended to state “a document display portion, an index field portion, and control portion all visibly defined in the display in separate portions thereof by the HTML document”; and Claims 41, 50 were amended to state “the display generated by the HTML document including a document display portion, an index field portion, and a control portion separately defined in the display.” For reasons of record, these amendments render the Claims patentable over the Quillix Data Sheet, Press Release, and Software Product.

Furthermore, the Quillix Data Sheet is itself the best source to determine what it states. It is improper to interpret Applicant’s statement in a manner contrary to the content of the documents. To interpret Applicant’s statement as an admission that the document is prior art in the presence of a print date of March 28, 2000 and the statement that the “Information in this document is subject to change without notice...” making it uncertain what it disclosed at any given time prior to its print date, would be contrary to what the document itself states. Applicant requests reversal of the rejection and remand with instructions to the Examiner to issue a Notice of Allowance for all pending claims.

3. Examiner's Refusal to Consider Alexandre Okonechnikov's Declaration is Contrary to Patent Rules (37 C.F.R. §1.131), Manual of Patent Examining Procedure (MPEP), Federal Rules of Evidence (FRE) and Due Process under U.S. Constitution, 5th Amendment

On Page 6 of the Office Action dated August 15, 2005, the Examiner refused to consider the Declaration of Alexandre Okonechnikov (submitted with Amendment filed July 21, 2005)

which establishes conception and actual reduction to practice before the date of the Quillix Data Sheet, Press Release or Product. As explained above in Item (1) Applicant has never admitted that the Quillix Data Sheet, Press Release or Product is prior art to the claimed invention. Refusal to consider the Declaration is contrary to the provisions of the Patent Rules (namely, 37 C.F.R. 1.131), MPEP §715, FRE 101 and 402; and Due Process of Law under the U.S. Constitution, 5th Amendment. Accordingly, reversal of the rejection and remand to the Examiner with instructions to issue a Notice of Allowance for all pending claims is requested on this ground.

4. Rejection under 35 U.S.C. 103(a) Based on Taking of Official Notice Without Motivation

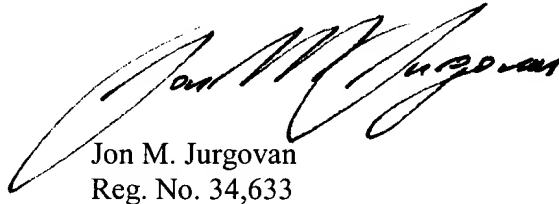
(1) The Examiner has taken Official Notice of numerous matters (Office Action dated 07-08-2003), and has failed to provide evidence to support the assertions after timely traversal of the taking of Official Notice (p. 34, Amendment dated 09-29-2003). The Examiner has attempted to abstract the claimed elements outside of the context of the claimed invention in an effort to assert that such elements are well-known by taking Official Notice. See pp. 7, 9, 10, 11, Office Action dated 07-08-2003: This is improper dissection of the claim language rejected by numerous BPAI and Federal Circuit decisions in favor of examining the claim as a whole. As noted in Applicant's Amendment dated 09-29-2003, the Examiner should be required to demonstrate the following or withdraw the rejection:

- (1) Scaling document data resulting from a document scan to fit within the document display of a web browser, along with the other claimed features, was known to those of ordinary skill in the art at the time the invention was made;
- (2) Scaling document data resulting from a scan to the same scale as a scanned document from within a web browser, along with the other claimed features, was known to those of ordinary skill in the art at the time the invention was made;
- (3) Using a mouse to press and release a control element on a web browser to control a scanner, along with the other claimed features, was known to those of ordinary skill in the art at the time the invention was made;
- (4) Generating a selection signal within a web browser of a client device indicating first, last, next, and/or previous scanned documents for display, along with the other claimed features, was known to those of ordinary skill in the art at the time the invention was made;

(5) A control element defined within a web browser capable of toggling to control scan and upload functions, along with the other claimed features, was known to those of ordinary skill in the art at the time the invention was made. The Examiner has failed to make any such showing and the rejection under 35 U.S.C. 103(a).

Furthermore, the Examiner has failed to demonstrate that a person of ordinary skill in the art would have been motivated to combine those features for which the Examiner has taken Official Notice with other references in an effort to obtain the claimed invention. There is simply no motivation, other than the Applicant's disclosure, that would have led a person of ordinary skill in the art to combine the features for which the Examiner has taken Official Notice with other references in an effort to obtain the claimed invention. Accordingly, reversal of the rejection and remand to the Examiner with instructions to issue a Notice of Allowance for all pending claims is requested for this additional reason.

Respectfully submitted,



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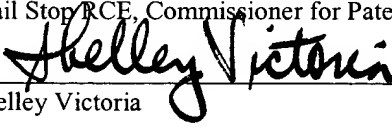
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Date of Deposit September 28, 2005

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Shelley Victoria